

THIS DISPOSITION IS
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OF THE TTAB

Mailed: February 23, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Volvo Penta of the Americas, Inc.

Serial No. 76416351

Kevin W. Grierson of Willcox & Savage, P.C. for Volvo Penta
of the Americas, Inc.

Won T. Oh, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney).

Before Seeherman, Hohein and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Applicant has filed an application seeking to register
on the Supplemental Register the mark OCEAN SERIES for
"marine engines" in International Class 7.¹

¹ The application filed on June 3, 2002 sought registration on the Principal Register, and was based on applicant's claimed dates of first use and first use in commerce of August 1, 2000 and November 1, 2001, respectively. When the Examining Attorney refused registration of the mark as merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), applicant amended its application to seek registration on the Supplemental Register. (Applicant's brief and request for remand, p. 12, filed January 16, 2004, via certificate of mailing.) The Examining Attorney accepted the amendment to the

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the three previously registered marks listed below, all issued to Kenneth F. Klus, dba Ocean Pro Engineering:

(1) Registration No. 1517776, issued December 27, 1989 on the Principal Register, for the mark shown below



("OCEAN," and "PRODUCTS ca., u.s.a." disclaimed) for "marine propulsion engines and parts therefor, namely exhaust kits, exhaust manifolds, exhaust chambers, carburetors, pumps, intake manifolds, cylinders, propellers, velocity stacks, fly wheels, impellers, crankshafts, piston kits, replacement sleeves, aluminum cylinder heads, flywheel bearing support, head washers, pump assemblies, driveshafts, and the like" in International Class 7;²

Supplemental Register and withdrew the refusal to register under Section 2(e)(1) in his Office action dated April 9, 2004.

² Section 8 affidavit accepted; Section 15 affidavit acknowledged. The registration includes goods in International Class 12 but they were neither cited nor argued by the Examining Attorney as a bar to registration of applicant's mark.

(2) Registration No. 2005577, issued under Section 2(f) of the Trademark Act on the Principal Register on October 8, 1996, for the mark OCEAN PRO for the same identified International Class 7 goods as listed above except that the words "and the like" do not appear in this identification, and the words "excluding marine outboard motors and component parts therefor" do appear as the end phrase of this identification;³ and

(3) Registration No. 2590591, issued under Section 2(f) of the Trademark Act on the Principal Register on July 9, 2002, for the mark OCEAN PRO for "inboard and outboard engines for recreational boats and water craft" in International Class 7.

When the refusal was made final, applicant appealed. Briefs have been filed. Applicant did not request an oral hearing.

Preliminarily, we note that applicant filed its amendment to the Supplemental Register, as well as additional evidence, with its brief on the case and requested a remand to the Examining Attorney. On February 24, 2004, the Board remanded the application to the

³ Section 8 affidavit accepted; Section 15 affidavit acknowledged. This registration also includes goods in International Class 12 that were not cited or argued by the Examining Attorney as a bar to registration of applicant's mark.

Examining Attorney for consideration of applicant's proposed amendment to the Supplemental Register. However, the Board, for the reasons explained therein, denied applicant's request to remand to the Examining Attorney for consideration of the affidavit of Paul Geraci and additional exhibits, even though the Board explained that the Examining Attorney could consider the affidavit and exhibits if he chose to do so.

The Examining Attorney chose not to consider the additional evidence, and in his brief on the case he objected to the affidavit and additional evidence submitted with applicant's brief as untimely under Trademark Rule 2.142(d). Applicant withdrew its additional evidence regarding third-party uses of marks (reply brief, p. 4); but applicant argued that one third-party registration should be considered because it was first argued by applicant in its response to the first Office action, and was therefore properly in the record.

We agree with applicant that its reference to canceled Registration No. 1762455 for the mark OCEANRUNNER for "marine engines, outboard motors and internal combustion engines, all for boats, and parts therefor" is of record and has been considered. However, this third-party registration is of record only because the Examining

Attorney waived any objection thereto by not pointing out to applicant that a proper copy of the third-party registration must be submitted (see *in re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974), and by the Examining Attorney responding to the merits of applicant's argument in relation thereto (see Final Office action, unnumbered pages 2-3).

Turning now to the substantive issue before us, our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We consider first applicant's goods and the cited registrant's goods. In this case, applicant identified its goods as "marine engines." In registrant's three

registrations the most relevant goods are identified respectively as "marine propulsion engines and parts therefor"; "marine propulsion engines and parts therefor, ... excluding marine outboard motors and component parts therefor"; and "inboard and outboard engines for recreational boats and water craft." It is clear that, as identified, applicant's goods and registrant's goods are closely related, if not legally identical goods.

However, applicant argues that the involved goods (engines for marine craft) are expensive and represent a "highly specialized market" (brief, p. 11); and that the purchasers are sophisticated customers who are unlikely to be confused regarding the source of these goods. The Examining Attorney argues that there is no evidence of record to support applicant's assertion, but he acknowledges that "given that these goods in general are not common household items, it would be reasonable to presume that the class of purchasers would be a limited group of consumers." (Brief, unnumbered page 7.)

Applicant's specimen of record includes the following statements:

OCEAN SERIES. BUILT TO SURVIVE IN A
SALTWATER WORLD.
It's a harsh world. But with an Ocean
Series propulsion system, your

investment and your days of fishing are secure for years to come.

An Ocean Series propulsion system eliminates outboards from the transom, leaving nothing to stand between the fisherman and the fish.

We find that purchasers of "marine engines" could include boat manufacturers and/or individuals who are boat owners, and we further find that the goods are not purchased on impulse, but rather are purchased only after some consideration. Certainly, any consumer of a marine engine must purchase with sufficient care that the engine will properly "fit" on or with the boat for which the engine is intended.

Turning now to the marks, it is well settled that marks must be considered in their entirety because the commercial impression of a mark on an ordinary consumer is created by the mark as a whole, not by its component parts. This principle is based on the common sense observation that the overall impression is created by the purchaser's cursory reaction to a mark in the marketplace, not from a meticulous comparison of it to others to assess possible legal differences or similarities. See 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2001). See also, *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255 (TTAB 1980). The proper

test in determining likelihood of confusion does not involve a side-by-side comparison of the marks, but rather must be based on the similarity of the general overall commercial impressions engendered by the involved marks.

We consider first applicant's mark vis-a-vis the cited mark which is in special form. Registration No. 1517776 shows the mark in such a manner that the most prominent feature is the word PRO in large dark type with intersecting lines within the letters; the words "PRODUCTS ca., u.s.a." (disclaimed) appear below the large stylized word PRO; and finally, the word "OCEAN" (also disclaimed) appears in the smallest type between the letters "P" and "R." The only element these two marks share is the word "OCEAN." The cited registrant's mark creates a strikingly different commercial impression from that engendered by applicant's typed mark OCEAN SERIES.

The cited registrant's other mark is OCEAN PRO in typed form. This is a closer case, but again the only word the marks share is the highly descriptive word "OCEAN."⁴ In both applicant's and registrant's marks the word "OCEAN" is followed by a different, and highly suggestive, word -- "SERIES" or "PRO," respectively. As the Board stated in

⁴ The Examining Attorney's argument that the term "ocean" is generic for marine engines is not supported by this record.

The Wooster Brush Co. v. Prager Brush Co., 231 USPQ 316,
318 (TTAB 1986):

"... the scope of protection to those marks categorized as 'weak' marks has often been limited to the substantially identical notation and/or the subsequent use and registration thereof for substantially similar goods. Therefore, the addition of other matter to a highly suggestive or descriptive designation, whether such matter is equally suggestive or even descriptive, may be sufficient to avoid confusion."

As to connotation, the word "series" connotes that a line of marine engines usable in ocean water are made by applicant; whereas "pro," which is short for "professional," connotes that the registrant's marine propulsion engines and its inboard and outboard engines for recreational boats and water craft are top of the line or it suggests that they are either for experienced sailors or will make the user feel like a professional. We find that the marks OCEAN SERIES and OCEAN PRO are not similar in connotation.

When considered in their entirety, we find that applicant's mark and each of registrant's marks are not similar in sound, appearance, connotation and overall commercial impression. See *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992).

Based on the record in this ex parte appeal, we find that confusion is not likely.

Decision: The refusal to register under Section 2(d) of the Trademark Act is reversed as to each of the cited registrations.